

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)	
)	
Johannes LAUTERBACH et al.)	Group Art Unit: 2179
)	
Application No.: 10/676,364)	Examiner: Nicholas AUGUSTINE
)	
Filed: September 30, 2003)	Confirmation No.: 3223
)	
For: DEVELOPING APPLICATIONS)	
USING A METAMODEL)	

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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

REPLY BRIEF UNDER 37 C.F.R. § 41.41

Pursuant to 37 C.F.R. § 41.41 and in reply to the Examiner's Answer mailed September 18, 2008, the period for response extending through November 18, 2008, Appellants submit this Reply Brief, solely to address the "Response to Argument" section of the Examiner's Answer.

Remarks begin on the next page.

REMARKS

Appellants respectfully traverse the rejection of claims 1-22 under 35 U.S.C. § 102(b) as being anticipated by the combination of three references: “Using the SNAP Development Environment” (“*SNAP*”), “Using the WFT Development Environment” (“*ENV*”), and “Developing a WFT Workflow System” (“*WFT*”).

First, the use of multiple references in support of the rejection under § 102(b) is improper. M.P.E.P. § 2131.01 states:

Normally, only one reference should be used in making a rejection under 35 U.S.C. 102. However, a 35 U.S.C. 102 rejection over multiple references has been held to be proper when the extra references are cited to:

- (A) Prove the primary reference contains an “enabled disclosure;”
- (B) Explain the meaning of a term used in the primary reference; or
- (C) Show that a characteristic not disclosed in the reference is inherent.

The Examiner argues, “[s]ince[] these products [*SNAP*, *ENV*, and *WFT*] work together[,] they constitute a single reference and can be used as the basis for a rejection based on anticipat[ion] by a product offering.” Examiner’s Answer, p. 11. However, M.P.E.P. § 2131.01 is completely silent regarding “products work[ing] together” or “a product offering.” Therefore, the mere fact that multiple products work together or that multiple products are offered as a single product package are not proper bases for using multiple references in a § 102 rejection.

Next, the Examiner argues that “[b]eing that [the combination of *SNAP*, *ENV*, and *WFT*] is single product offering[,] conditions A and C are met from MPEP 2131.01 in that . . . []*SNAP*[] is a piece of [a] entire software suite . . . and being that . . . []*ENV* and *WFT*[] detailing different pieces of the entire software suite which *SNAP* is apart [sic] of

. . . would be inherent.” Examiner’s Answer, p. 11. However, contrary to the Examiner’s allegation, conditions (A) and (C) of M.P.E.P. § 2131.01 are not met in this case.

“[A] 35 U.S.C. 102 rejection over multiple references has been held to be proper when the extra references are cited to[] (A) [p]rove the primary reference contains an ‘enabled disclosure;’ . . . or (C) [s]how that a characteristic not disclosed in the reference is inherent.” M.P.E.P. § 2131.01. However, *ENV* and *WFT* were not cited to prove that *SNAP* contains an enabled disclosure or to show that a characteristic not disclosed in *SNAP* is inherent. Before the Examiner’s Answer, the Examiner never mentioned that that *ENV* and *WFT* are being cited to prove that *SNAP* contains an enabled disclosure or to show that a characteristic not disclosed in *SNAP* is inherent. For example, the Examiner failed to set forth in the Final Office Action how *ENV* and *WFT* prove that *SNAP* contains an enabled disclosure or how *ENV* and *WFT* show that a characteristic not disclosed in *SNAP* is inherent. In fact, the Final Office Action is completely silent with respect to any enablement issue or any inherency issue regarding *SNAP*. Contrary to the Examiner’s newly-formed allegation that *ENV* and *WFT* were combined with *SNAP* for enablement and inherency purposes, *ENV* and *WFT* were cited in the Final Office Action as allegedly containing teachings of various elements of Appellant’s claims. See, e.g., Final Office Action, pp. 6, 9, and 10. Therefore, the Examiner’s statement that combining *ENV* and *WFT* with *SNAP* meets conditions (A) and (C) of M.P.E.P. § 2131.01 is incorrect. Accordingly, the use of *SNAP*, *ENV*, and *WFT* in support of the rejection under § 102(b) is improper.

Even assuming that *SNAP*, *ENV*, and *WFT* were properly combined, which they were not, the combination of *SNAP*, *ENV*, and *WFT* fails to anticipate Appellants' claims.

Independent claim 1 recites a combination including, for example, "a model class associated with the component class, the model class including a model-class class." *SNAP*, *ENV*, and *WFT* do not teach or suggest at least these elements of claim 1.

The Examiner alleges: "A Display class [in *SNAP*] functions as [the claimed] 'component class.' A GUI Class [in *SNAP*] functions as [the claimed] 'model class.' A Domain class [of *SNAP*] . . . functions as [the claimed] 'model-class class.'" Examiner's Answer, p. 12. Even assuming this is correct, which it is not, *SNAP* fails to disclose any GUI Class associated with a Display Class or any GUI Class that includes a Domain Class. In other words, even assuming that *SNAP* discloses the claimed classes, which Appellants do not concede, *SNAP* fails to teach or suggest the claimed relationships (e.g., "associated with" and "including") among the claimed classes. Therefore, *SNAP* fails to teach or suggest "a model class associated with the component class, the model class including a model-class class," as recited in claim 1. Furthermore, *ENV* and *WFT* fail to cure the deficiencies of *SNAP* at least because *ENV* and *WFT* also fail to teach or suggest "a model class associated with the component class, the model class including a model-class class," as recited in claim 1. Accordingly, *SNAP*, *ENV*, and *WFT* fail to anticipate claim 1.

Independent claims 13 and 16, although different in scope from claim 1, are allowable for at least the same reasons as claim 1. In addition, dependent claims 2-12,

14, 15, and 17-22 are allowable at least due to their dependence from allowable independent claims 1, 13, and 16.

CONCLUSION


For at least the foregoing reasons and the reasons given in Appellants' Appeal Brief filed on June 3, 2008, Appellants respectfully request that the Board reverse the rejection of claims 1-22 under 35 U.S.C. § 102(b) as being anticipated by the combination of *SNAP*, *ENV*, and *WFT*.

Please charge any required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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Dated: November 18, 2008

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